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09/745,669	12/21/2000	Brian M. Siegel	50N3787	5754

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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

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09/745,669

EXAMINER

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/745,669
Filing Date: December 21, 2000
Appellant(s): SIEGEL ET AL.

KARIN L. WILLIAMS
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 26 June 2006 appealing from the Office action mailed 10 January 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The brief is deficient because Appellant fails to identify which independent claim is being described in the various passages of his summary. However, rather than again returning the Brief as non-compliant¹, and in order to expedite Appeal, the Examiner submits the following mapping of appealed claims as best understood from appellant's Summary of Claimed Subject Matter.

Apparatus claims 1, 5 and 6	Appeal Brief
1. (Currently Amended) An apparatus for retrieving information related to a consumer product using a consumer product codes comprising:	The application describes an apparatus [<i>Ex. note: claim 1</i>] for retrieving information related to a consumer product using a consumer product codes [sic] including

¹ Appellant's Appeal Brief of 27 April 2006 was returned as non-compliant on 24 May 2006.

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Apparatus claims 1, 5 and 6	Appeal Brief
a) a portable consumer good that lacks the capacity for data transmission, wherein said portable consumer good comprises a non-electronic device; and	[a] a portable consumer good that lacks the capacity for data transmission (lines 1-7, para. [0034]), wherein the portable consumer good comprises a non-electronic device (lines 1-7, para. [0034]), and
b) a scanning and storage device incorporated into said portable consumer good, said scanning and storage device including:	[b] a scanning and storage device incorporated into the portable consumer good (lines 7-8 of para. [0029], FIG. 1, para. [0034]), the scanning and storage device including
(i) a scanning element converting a product code symbol into machine readable information representative of said product code; and	[b.i] a scanning element converting a product code symbol into machine readable information representative of the product code (lines 1-3 para. [0029]) and
(ii) a removable memory medium to which said information is stored.	[b.ii] a removable memory medium to which the information is stored (paras. [0039] - [0040]).
5. (Previously Presented) The apparatus according to claim 1, wherein said non-electronic device comprises one of the following: an article of clothing, a pen and a pocketbook.	[Ex. note: not summarized by appellant]
6. (Original) The apparatus according to claim 1, wherein said removable memory medium comprises one of the following: a magnetic disc, flash memory, a smart card, a memory stick, a diskette, a CD-ROM, a disk drive, a random access memory chip, and an optical storage device.	

Apparatus claim 7	Appeal Brief
7. (Currently Amended) An apparatus for retrieving and processing information related to a consumer product using a universal product code comprising:	A further embodiment [Ex. Note: apparatus claim 7] includes
a) a portable consumer device, said portable consumer device including: (i) a portable consumer good comprising a non-electronic device that lacks the capacity for data transmission; and (ii) a scanning and storage device incorporated into said portable consumer good, said scanning and storage device comprising: (1) a scanning element converting a printed universal product code symbol into machine readable information representative of said universal product code; and (2) a removable memory medium to which said information is stored; and	[Ex. notes: appellant provides no support for [a] [a.i] [a.ii] [a.ii.1] [a.ii.2], but alleges that claim 7 "...includes all of the elements recited in independent claim 1..." Brief, p. 5]
b) an Internet-ready device couplable to one or	[b] an Internet-ready device couplable to one or

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Apparatus claim 7	Appeal Brief
more Internet-based information servers, said Internet-ready device including a removable memory medium adapted to accept said removable memory medium from said scanning and storage device.	more Internet-based information servers (lines 2-3 of para. [0035], para. [0036], para. [0041], para. [0042]), said Internet-ready device including a removable memory medium (lines 4-5 paras. [0043], para [0044] - [0047]) adapted to accept said removable memory medium from said scanning and storage device (lines 6-7 para. [0040], Figs. 3 and 4).

Method claims 28, 31 and 32	Appeal Brief
28. (Previously Presented) A method for retrieving information related to a consumer product comprising the steps of:	A method [Ex. Note: claim28] is also described, far retrieving information related to a consumer product comprising the steps of
integrating a bar code scanner and a removable memory into a consumer good, wherein said consumer good comprises a non-electronic device;	integrating a bar code scanner and a removable memory into a consumer good, wherein the consumer good comprises a non-electronic device (para. [00291 and 10034]),
scanning a bar code of a selected consumer product using the integrated scanner and storing the scanned bar code in the removable memory;	scanning a bar code of a selected consumer product using the integrated scanner and storing the scanned bar code in the removable memory (para. [0028], [0039] and [0040]),
transferring the scanned bar code from the removable memory to a computer network; and	transferring the scanned barcode from the removable memory to a computer network (para. [0040]) and
accessing a web site on a computer network based on the scanned bar code, wherein said web site includes information related to the selected consumer product.	accessing a web site an a computer network based on the scanned bar code (paras. [0041]), wherein the web site includes information related to the selected consumer product (para. 0043], para. [0044], and FIG. 3).
31. (Original) The method according to claim 28, further comprising converting a scanned bar code to a uniform resource locator (URL) of a web site.	[Ex. note: Not summarized by appellant]
32. (Original) The method according to claim 28, further comprising converting a scanned bar code and a global position to a uniform resource locator (URL) of a web site.	

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal. Appellant has not provided a separate **IX Evidence Appendix**. The Examiner concludes that Appellant indicates that there is none.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 5-7, 28 and 31-32 are rejected under 35 USC 103(a) as being unpatentable over Schena (US 6,448,979 B1) in view of Kocher (US 6,652,455 B1).

(10) Response to Argument

The Examiner provides the following mapping to facilitate review of the Brief.

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	Brief	content	Appellant's Arguments/conclusions
A	page 5, lines 1-22	Appellant paraphrases several limitations of Claims 1, 7 and 28	None
B	page 5, line 23- page 6, line 18	Appellant appears to quote from various Office Actions	None
C	page 6, line 19- page 7, line 2	Appellant provides a piecemeal analysis of Schena and quotes the Abstract and Col. 1, lines 52-54, Col. 5, lines 37-39, Col. 6, lines 27-31, Col. 7, lines 14-16, Col. 9, lines 30-33	... Schena does not teach or suggest, nor would one of ordinary skill in the art be motivated... to modify Schena to include a removable memory device... [Brief, page 6, lines 23-25]
D	page 7, lines 2-26	Appellant provides a piecemeal analysis of Kocher, relying on Col. 5, lines 13-17, col. 5, lines 26-29 (twice), col. 5, lines 30-34, Col. 6, lines 10-15, col. 6, lines 62-65	<p>... Kocher, relied upon for teaching a removable memory device, is directed to a device specifically designed "for scanning"- unlike Applicants' claimed invention that recites [paraphrased claim 1.a] unlike Applicants' claimed invention that recites a portable consumer good that lacks the capacity for data transmission and comprises a non-electronic device -- and that has a scanning a storage device incorporated therein [Brief, page 7, lines 3-6]</p> <p>... The removable memory module of Kocher does not ... store information that is created from the product code symbol that is scanned - but rather [quote from Kocher] [Brief, page 10-14, citation omitted]</p> <p>... Kocher does not teach or suggest <u>storing scanned information</u> in a removable memory medium, wherein the removable memory medium may be removed therefrom and inserted into an internet-ready device. [Brief, page 7, lines 16-18, emphasis in original]</p>
E	Page 7, line 27- page 8, line 2	Appellant appears to conclude that Schena and Kocher do not teach or suggest [...a limitation not found in the claims...]	There is absolutely no teaching or suggestion in either ... of <i>a removable memory medium (for storing machine readable information representative of a scanned product code symbol) in a portable consumer good that lacks the capacity for data transmission that can be removed from the portable consumer good and inserted into an internet-ready device.</i> [Brief, page 7, line 27-page 8, line 2]
F	Page 8, lines 3-15	Appellant quotes requirements of prima facie case of obviousness and appears to conclude that his invention is not taught or suggested by Schena and Kocher and would not be obvious in light of any combination of Schena and Kocher.	
G	Page 8, lines 16-27	Appellant appears to argue that the Office relied on hindsight and used his invention as a roadmap	... without the teachings provided by Appellant's disclosure ... "road map" to piece together the teachings of the prior art... even if one used impermissible hindsight and combined the teachings of the references, the present invention would not be achieved.
H	Page 8, line 28- page 9, 2	Accordingly, Appellants respectfully submit that independent Claims 1, 7 and 28, and dependent Claims 5-6 and 31-32, of the present invention are not taught or suggested by Schena and Kocher, and would not be obvious in light of any combination of the teachings of Schena and Kocher.	

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In A and B Appellant presents no arguments.

For C and D, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In D and E Appellant argues limitations that are not in the claims

...Kocher does **not** teach or suggest storing scanned information in a removable memory medium, *wherein the removable memory medium may be removed therefrom and inserted into an internet-ready device*. [Brief, page 7, lines 16-18, emphasis in original]

There is absolutely no teaching or suggestion in either ...of a *removable memory medium (for storing machine readable information representative of a scanned product code symbol) in a portable consumer good that lacks the capacity for data transmission that can be removed from the portable consumer good and inserted into an internet-ready device*. [Brief, page 7, line 27-page 8, line 2]

In response to these arguments, the Examiner notes that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In C and G, Appellant questions the motivation to combine references:

...Schena does **not** teach or suggest, nor would one of ordinary skill in the art be motivated (in light of the teachings of Kocher at least), to modify Schena to include a removable memory device...[Brief, page 6, lines 23-25]

Appellant further respectfully submits that it is, of course, improper to pick and choose elements from several references in order to "build" an obviousness rejection, when such a combination would not in fact have been obvious to one of ordinary skill in the art. One of ordinary skill in the art would not have even considered turning to the alleged teachings of Kocher to "provide an old and well known option", without the teachings provided by Appellant's disclosure... Since there is no teaching in these references that would suggest each of the elements recited in the present claims, even if one used impermissible hindsight and combined the teachings of the references, the present invention would not be achieved. [Appeal Brief, page 8, last full paragraph]

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It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The knowledge was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure.

C and G (continued). In addition to motivations in the various Office Actions, Kocher provides additional motivations for combining the references. For example:

A basis for this invention is the notion of relating scanned data information for products and commodities to a database of information related to the product, such information being of interest to a consumer....The information can be **scanned from barcodes**, or text, or handwriting using an optical scanner. ...items are identified by means of a scanner, such as but not limited to, **a barcode scanner**. The device records the scanned data, the serving size (set by the user), and the time and date of consumption in **memory**. Optionally, a **UPC barcode** is used to extract from database information related to the item such as the product name, the brand name, and the recommended or default serving size, **nutrients and chemical components included in the product, and manufacturing processes that could affect the health of the user**. Consumption schedules are optionally set for each individual item and **are stored in memory**. This **latter option is used to indicate or to warn the user when consumption of items is required or to monitor over/under consumption of some items from a dietary point of view**. Kocher, col. 2, lines 34-59, emphasis added.

...a user is able to **record, over a long period of time**, consumed items, the consumed serving size, time, date, and location of consumption. In **a typical use of the invention**, it is able to **warn the user** when consumption time, such as for medicines, is due, or warn the user when over/under consumption occurs. In addition, the user may **store** a user medical profile to detect **potential allergy or incompatibility with consumed items**, and to **warn again of food and drug interference**...the user may later download by means of an interface the recorded information for further analysis; in this respect, a significant advantage for the invention is its use for compiling data over selected periods of time, either for personal information or the information of others such as medical practitioners or public **health** officials. Moreover, the use of **removable memory** (PCMCIA SRAM or Flash **Memory Cards**) to **store** databases makes it convenient to either change or update the databases. Kocher, col. 3, line 55-Col. 4, line 5, emphasis added.

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Mode V: Personal data update: To update the medical profile **stored in the removable memory module 36**, the 6-way switch 30 should be set on "personal data". Personal data defining the user medical profile such as size, age, weight, **incompatibility or allergy to some food or to some medications can be updated**. It should be noted that the memory module 36 could also be updated by retrieved data from a patient medical **record maintained by an authorized health practitioner, or from hospital records...** Kocher, col. 8, lines 16-26, emphasis added.

D and E Appellant incorrectly paraphrases limitations found in several claims and argues repeatedly that the references do not disclose various combinations of

"...portable consumer good..."
"...lacks the capacity for data transmission..." and
"...non-electronic device..."

Kocher...unlike Applicants' claimed invention that recites [paraphrased claim 1.a] unlike Applicants' claimed invention that recites **a portable consumer good that lacks the capacity for data transmission** and comprises a **non-electronic device** -- and that has a scanning a storage device incorporated therein [Brief, page 7, lines 3-6], D above]

... There is absolutely no teaching or suggestion in either ...of *a removable memory medium (for storing machine readable information representative of a scanned product code symbol) in a portable consumer good that lacks the capacity for data transmission that can be removed from the portable consumer good and inserted into an internet-ready device*. [Brief, page 7, line 27-page 8, line 2, E above]

Again, the Examiner notes the quoted limitations are not in the claims. The Examiner also notes that the references indeed disclose the limitations found in claims 1, 5, 7 and 28, copied below for convenience:

Claim 1 (a) a **portable consumer good** that lacks the capacity for data transmission, wherein said **portable consumer good** comprises a **non-electronic** device; and
Claim 1 (b) a scanning and storage device incorporated into said **portable consumer good**, said scanning and storage device including:

Claim 5. (Previously Presented) The apparatus according to claim 1, wherein said **non-electronic** device comprises one of the following: an article of clothing, a pen and a pocketbook. [Ex. note: not argued and summarized by Appellant]

Claim 7 (a) [Ex. note: not argued and summarized by Appellant]
a portable consumer device, said portable consumer device including:
(i) a **portable consumer good** comprising a **non-electronic** device that lacks the capacity for data transmission; and
(ii) a scanning and storage device incorporated into said **portable consumer good**, said scanning and storage device comprising:
(1) a scanning element converting a printed universal product code symbol into machine readable information representative of said universal product code; and
(2) a removable memory medium to which said information is stored; and

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Claim 28 ...integrating a bar code scanner and a removable memory into a consumer good, wherein said consumer good comprises a **non-electronic** device...

Appellant's claim limitations appear to be based on the following:

[0035] The portable scanning and storage device can also be incorporated into non-electronic, portable consumer goods such as **pens**, clothing (e.g., gloves), pocketbooks, and so forth. In these embodiments, additional circuitry may be necessary to provide the functionality. For example, the memory, controller (processor) and scanner circuitry may be incorporated into the consumer good to enable complete functionality. Power can be provided by solar cells or batteries, for example. [emphasis added]

The limitation is disclosed by Schena, Col. 3, lines 48-56, for example:

The scanner 100 may be a handheld device, preferably, but not necessarily, wireless. The scanner 100 may be, for example, an enhanced existing electronic device, a TV remote control, a mouse, a cell phone, a PC card device, a palmtop, a calculator, a key chain, **a pen**, an identification card, a smart card, a hand held GPS device, a desktop or laptop computer, a digital appliance, a microprocessor-based device., a personal digital assistant, a pager or a two-way pager. [emphasis added]

Therefore, Appellant's arguments are not persuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

The Examiner notes that appellant has not provided a separate **RELATED APPEALS APPENDIX** but respectfully directs the Board's attention to Appeal Brief page 2, item II, RELATED APPEALS AND INTERFERENCES, which states:

No other appeals or interferences are known to Appellant, Appellant's legal representative, or the assignees, which will directly affect, be directly affected by, or have a hearing on the Board's decision in the pending appeal.

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Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

James Zurita
Primary Examiner

James Zurita
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